



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

Paper No.

ELAN DRUG DELIVERY, INC.  
C/O FOLEY & LARDNER LLP  
3000 K STREET, N.W.  
SUITE 500  
WASHINGTON DC 20007-5109

**COPY MAILED**

**MAR 30 2009**

**OFFICE OF PETITIONS**

In re Application of	:	
Rajeev A. Jain, Jon Swanson,	:	
Robert Hontz, John Devane,	:	
Jenneth Iain Cumming, Maurice	:	
Joseph Anthony Clancy, and	:	
Janet Elizabeth Codd	:	DECISION ON TWO PETITIONS
Application No. 09/337,675	:	UNDER
Filing Date: June 22, 1999	:	37 C.F.R. §§ 1.48 AND 1.183
Attorney Docket Number:	:	
029318/0497	:	
Title: CONTROLLED-RELEASE	:	
NANOPARTICULATE COMPOSITIONS	:	

Background

This is a decision on the two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on July 3, 2008. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

Receipt of the July 17, 2008 supplement to the petition pursuant to 37 C.F.R. § 1.48(a)(3) petition is acknowledged.

In short, Petitioner has requested that Gary Liversidge be added as an inventive entity, and that the Office waive the requirement that the applicant provide an oath or declaration by the actual

inventors (Petitioner has submitted declarations that have been executed by each of the inventors save Mr. Cumming). With these submissions, Petitioner has submitted, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R. § 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

The petition pursuant to 37 C.F.R. § 1.48(a)(3) is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED**.

A discussion follows.

#### Applicable Rules

37 C.F.R. § 1.48(a) sets forth, *in toto*:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

Analysis of the Petition Pursuant to Rule § 1.183

With this petition, Petitioner has requested the waiver 37 C.F.R. § 1.64. This request is being treated as a request for the waiver of 37 C.F.R. § 1.48(a)(3).

In order to submit a grantable petition pursuant to 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has asserted, *much less established*, that either condition exists in this case. As such, the circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

Assuming *arguendo* that Petitioner had made these two assertions, there does not appear to be anything extraordinary about an Applicant who is faced with the requirement that each of the inventors must execute a declaration, and that justice requires the waiver of the Office requirement that the declaration be executed by each inventor.

Analysis of the Petition Pursuant to Rule § 1.48(a)(3)

Petitioner has met requirements (1) - (2) and (4) - (5) of Rule § 1.48. Regarding the third requirement, Petitioner has failed to provide an oath or declaration that has been executed by the actual inventors, as required by 37 C.F.R. § 1.63, and pursuant to the discussion above, this requirement has not been waived.

Conclusion

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.48 and 1.183". This is not a final agency action within the meaning of 5 U.S.C § 704.

Petitioner will note that a grantable petition pursuant to 37 C.F.R. § 1.47(a) must be filed, before the Office will accept a partially-executed declaration.<sup>1</sup>

---

<sup>1</sup> See MPEP §§ 409, 409.03, 409.03(a), and 409.03(d).

It is noted that the Arthur, Elliott, and Willis declarations of facts each refer to Internet searches that were performed for non-signing inventor Cumming. Petitioner may wish to consider submitting a Rule 1.47(a) petition, along with a copy of these searches, so as to place the Office in a position where it can be determined whether the searches were sufficiently broad so as to provide a reasonable chance at locating this individual.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,<sup>2</sup> hand-delivery,<sup>3</sup> or facsimile.<sup>4</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>5</sup>

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.<sup>6</sup>

/Paul Shanoski/  
Paul Shanoski  
Senior Attorney  
Office of Petitions

---

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

3 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

4 (571) 273-8300- please note this is a central facsimile number.

5 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.